

REMARKS

Claims 1 to 17 and 19 to 43¹ were pending in this application. Claims 1 to 17 and 19 to 30 are rejected, claims 32 to 43 are withdrawn from consideration, and claim 31 is objected to. Applicants acknowledge with appreciation the Examiner's statement that objected claim 31 would be allowable if rewritten in independent form (Office Action, mailed February 20, 2009, at page 16).

In view of their withdrawal from consideration, claims 32 to 43, directed to a non-elected invention, have been canceled without prejudice. In order expedite prosecution and without conceding to the propriety of any rejections, claims 1 to 17 and 19 to 31 have also been canceled without prejudice and new claims 44 to 65 have been added. Applicants reserve the right to pursue the subject matter of the canceled claims in the present application or one or more related applications.

As suggested by the Examiner, the limitations of objected claim 31 have been incorporated into new independent claims 44 to 48. New claims 49 to 65 depend directly or indirectly from one or more of claims 44, 45, 46, 47 or 48. New claims 44 to 65 are fully supported by the specification as originally filed, see, *e.g.*, the table below for examples of support in the specification for the amended claims. Thus, no new matter has been added. After entry of the present Amendment, claims 44 to 65 will be pending.

<u>Claim No.</u>	<u>Examples of Support in Specification</u>
44, 46, 47	page 2, ¶ 8; pages 7 to 8, ¶ 23; page 11, ¶¶ 32 and 35; page 12, ¶ 37 to page 13, ¶ 38; pages 80 to 81, ¶ 206
45, 48, 49	page 2, ¶ 8; page 7, ¶ 22; page 11, ¶ 35; page 65, ¶ 159; page 12, ¶ 37 to page 13, ¶ 38; pages 80 to 81, ¶ 206
50, 51	page 25, ¶ 82
52	pages 10 to 11, ¶ 31
53	page 63, ¶ 153
54	page 156, ¶ 448

¹ Applicants note that claim 18 was cancelled, without prejudice, in the Response to Restriction Requirement & Preliminary Amendment filed November 17, 2009.

<u>Claim No.</u>	<u>Examples of Support in Specification</u>
55	page 53, ¶ 124
56	page 63, ¶ 153
57	page 65, ¶ 159
58	page 130, ¶ 356
59	pages 130 to 131, ¶ 357
60	pages 25 to 26, ¶ 85; Figure 1
61	pages 10 to 11, ¶ 31
62, 63	page 11, ¶ 34
64, 65	page 73, ¶ 182

Sequence Compliance

The Examiner has objected to the specification for failing to identify nucleotide sequences of at least 10 nucleotides in Figure 1 of the specification by a proper sequence identifier, i.e., “SEQ ID NO:”. Applicants submit that the six nucleotide sequences that are shown in Figure 1C of the application were included in the sequence listing filed on October 23, 2006 (SEQ ID NOs: 69-74), but were not identified in the specification. In addition, the nucleotide sequence shown in Figure 2A was also included in the sequence listing filed on October 23, 2006 (SEQ ID NO: 75), but was not identified in the specification. The description of Figure 1C on page 25 of the specification has been amended to insert the sequence identifiers, SEQ ID NOs: 69-74, that correspond to the six nucleotide sequences that are shown in Figure 1C. The description of Figure 2A on page 26 of the specification has been amended to insert the sequence identifier, SEQ ID NO: 75, that corresponds to the nucleotide sequences that is shown in Figure 2A.

Applicants also submit herewith a Substitute Sequence Listing in paper and computer-readable format pursuant to 37 C.F.R. § 1.821(c) and (e). Please replace the paper copy and CRF of the Sequence Listing filed on October 23, 2006 with the paper copy and CRF of the Substitute Sequence Listing submitted herewith. In the sequence listing filed on October 23, 2006, SEQ ID NO:69 contained 36 nucleotides, but included an additional nucleotide, “g” formally at position 29, which has now been removed. The new SEQ ID NO:69 contains a

total of 35 nucleotides. SEQ ID NO:73 had an incorrect nucleotide “c” at position 35, which has now been correctly changed to nucleotide “g.” SEQ ID NO:75 had an incorrect nucleotide “c” at position 27, which has now been correctly changed to nucleotide “g.” The Substitute Sequence Listing contains no new matter.

The Rejection Under 35 U.S.C. § 112, Second Paragraph, Should Be Withdrawn

Claim 43 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. In particular, the Examiner alleges that it is unclear whether the VEGF UTR is incorporated into the method of claim 43 and compared side-by-side with the UTR of other genes. Applicants submit that the cancellation of claim 43 renders the rejection of this claim moot and respectfully request that the rejection under 35 U.S.C. § 112, second paragraph, be withdrawn.

The Rejection Under 35 U.S.C. § 102 Should Be Withdrawn

Claims 1, 3-5, 7, 9, 13-16, 18, 19, 22, 24-26, 29, and 43 are rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Hyder *et al.*, 2000, Cancer Research, 60: 3183-3190 (“Hyder”). Applicants respectfully disagree.

However, in order to expedite prosecution of the application and without conceding to the propriety of the rejection, claims 1, 3-5, 7, 9, 13-16, 18, 19, 22, 24-26, 29 (as well as claims 2, 6, 8, 10-12, 20, 21, 23, 27, 28 and 30-43) have been canceled without prejudice, and new claims 44 to 65 have been added. Applicants submit that the new claims obviate the rejection under 35 U.S.C. § 102(b).

The new claims are directed to a method for identifying a compound that modulates UTR-dependent expression of a human VEGF protein and disrupts an interaction between the 5’ UTR and the 3’UTR of human VEGF mRNA. As acknowledged by the Examiner, “the prior art does not teach or reasonably suggest a compound that disrupts an interaction between the 5’ UTR and the 3’ UTR of the VEGF gene” (see February 20, 2009 Office Action at page 16). Accordingly, the rejection under 35 U.S.C. § 102(b) is moot and should be withdrawn.

The Rejections Under 35 U.S.C. § 103 Should Be Withdrawn

Claims 2, 10-12, 17, 20, 21, and 30 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Hyder as applied to claims 1, 3-5, 7, 9, 13-16, 18, 19, 22, 24-26, 29, and 43, and further in view of Levy *et al.*, 1998, J. Biol. Chem. 273(11): 6417-6423. Claims 6 and 8 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Hyder as applied to claims 1, 3-5, 7, 9, 13-16, 18, 19, 22, 24-26, 29, and 43, and further in view of Iida *et al.*, 2002, Life Sciences, 71: 1607-1614. Claim 9 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Hyder as applied to claims 1, 3-5, 7, 9, 13-16, 18, 19, 22, 24-26, 29, and 43, and further in view of Benjamin *et al.*, 1997, PNAS, 94: 8761-8766. Claims 23, 27, and 28 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Hyder as applied to claims 1, 3-5, 7, 9, 13-16, 18, 19, 22, 24-26, 29, and 43, and further in view of Cho *et al.*, 2002, Expert Opin Ther Targets, 6(6): 679-689. Claim 43 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Hyder as applied to claims 1, 3-5, 7, 9, 13-16, 18, 19, 22, 24-26, 29, and 43, and further in view of Eibl *et al.*, 1999, Plant Journal, 19(3): 333-345. Applicants respectfully disagree.

However, in order to expedite prosecution of the application and without conceding to the propriety of the rejection, claims 1 to 17 and 19 to 43 have been canceled without prejudice, and new claims 44 to 65 have been added. Applicants submit that the new claims obviate the rejection under 35 U.S.C. § 103(a).

The new claims are directed to a method for identifying a compound that modulates UTR-dependent expression of a human VEGF protein and disrupts an interaction between the 5' UTR and the 3'UTR of human VEGF mRNA. As acknowledged by the Examiner, "the prior art does not teach or reasonably suggest a compound that disrupts an interaction between the 5' UTR and the 3' UTR of the VEGF gene" (see February 20, 2009 Office Action at page 16). Accordingly, the rejections under 35 U.S.C. § 103(a) are moot and should be withdrawn.

CONCLUSION

Applicants believe that the present claims meet all the requirements for patentability. Consideration and entry of the foregoing amendments and remarks into the file of the application is respectfully requested. Withdrawal of all rejections and consideration of the amended claims are requested.

If any issues remain, the Examiner is urged to telephone the undersigned.

Respectfully submitted,

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